

Appl. No. 09/696,402
Amdt. Dated 06/22/2005
Reply to Office Action of 03/22/2005

REMARKS/ARGUMENTS

This Amendment is in response to the Office Action mailed March 22, 2005. In the Office Action, claims 20-38, 42-54, 58-70 and 74-77 were rejected under 35 U.S.C. §102, and claims 39-41, 55-57 and 71-73 were rejected under 35 U.S.C. §103. Applicants respectfully traverse these rejections in their entirety.

Herein, claims 20-21, 29-32, 34, 38-41, 44-46, 49-56, 58, 60, 62, 66-69, 71 and 76-77 have been revised. Claims 24-28, 33, 42-43, 57, 61 and 65 have been cancelled without prejudice. Claim 78 has been added. Reconsideration in light of the amendments and remarks made herein is respectfully requested.

Rejection Under 35 U.S.C. §102

Claims 20-38, 42-54, 58-70 and 74-77 were rejected under 35 U.S.C. § 102(b) as being anticipated by Hetherington (U.S. Patent 6,388,686). Applicants respectfully request the Examiner to withdraw the rejection because a *prima facie* case of anticipation has not been established.

As the Examiner is aware, to anticipate a claim, the reference must teach every element of the claim. "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Vergegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ 2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the...claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ 2d 1913, 1920 (Fed. Cir. 1989).

For instance, with respect to independent claim 20, Applicants respectfully submit that Hetherington does not describe a dial capable of being *physically rotated* to sequentially display a set of files. *Emphasis added*. Similar limitations regarding the physical nature of the dial is set forth in independent claims 29 and 34.

In addition, independent claim 38 is directed to a dial capable of being moved in a direction along the axis of rotation. Such movement is targeted to "flag" the currently displayed file (claim 39). Independent claims 44 and 60 are directed to the sequential display of

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presentations in a forward or reverse linear order depending on the rotational movement of the dial from a stop dial position. In contrast, Hetherington illustrates a rotate control (208) where the indicators (208a-208f) simply identify the particular display item. These indicators do not indicate a direction of rotation linear order for future presentations nor the speed of rotation computed based on the radial position of the dial (see claim 78).

Hence, Applicants respectfully request the Examiner to reconsider the outstanding §102(b) rejections based on the amendments and remarks set forth above, and upon reconsideration, withdraw the outstanding §102(b) rejection.

Rejection Under 35 U.S.C. § 103

Claims 39-41, 55-57 and 71-73 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Hetherington in view of Wynn (U.S. Patent 6,734,883). Applicants respectfully traverse the rejection because a *prima facie* case of obviousness has not been established.

As the Examiner is aware, to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify a reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all of the claim limitations. See MPEP §2143; see also *In Re Fine*, 873 F. 2d 1071, 5 U.S.P.Q.2D 1596 (Fed. Cir. 1988). Herein, the combined teachings of the cited references fail to describe or suggest all the claim limitations.

With respect to claims 39-41, neither Hetherington nor Wynn, alone or in combination, describes or suggests a dial that can be *moved in a direction along its axis of rotation* for selection of a file being part of the set of files. *Emphasis added*. This limitation is further included in independent claim 38 as amended. The movement of the dial as claimed (i.e., pushed in) causes an event to be performed on the currently displayed file. Examples of various events may include, but are not limited to flagging the file for easy return or removal of the file from the

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set of files. Similarly, with respect to claims 71-73, neither Hetherington nor Wynn, alone or in combination, describes or suggests a dial that can be "*pushed in*" to select or unselect a presentation corresponding to a still image. *Emphasis added.*

Hence, Applicants respectfully request the Examiner to reconsider the outstanding §103(a) rejection based on the amendments and remarks set forth above, and upon reconsideration, withdraw the outstanding §103(a) rejection.

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Conclusion

Applicants respectfully request that a timely Notice of Allowance be issued in this case.

Respectfully submitted,

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Dated: June 22, 2005

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